

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application of:

Engstrom, G. Eric

Application No.: 09/872,293

Filed: May 31, 2001

For: METHOD AND APPARATUS FOR  
MASKING PRIVATE MAILING  
ADDRESS INFORMATION BY  
MANIPULATING DELIVERY  
TRANSACTIONS

Examiner: Kalinowski, A.

Art Unit: 3627

Confirmation No.: 2368

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APPELLANT'S APPEAL BRIEF

TO THE HONORABLE COMMISSIONER FOR PATENTS:

This brief is in support of a Notice of Appeal to the Board of Patent Appeals and Interferences filed concurrently, appealing the decision of the Examiner in the Final Office Action mailed April 19, 2006 ("Final Office Action"), in which the claims of the above-captioned application were again rejected. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application.

Although the Advisory Action indicates a filing date of June 22, 2006, for the Response After Final Rejection, the response was actually filed on June 19, 2006, and thus within 2-months of the mailing date of the Final Office Action. Therefore, the present Appeal Brief and concurrently filed Notice of Appeal are being filed within one-month of the mailing date of the Advisory Action along with a request for a one-month extension of time.

I. REAL PARTY IN INTEREST

The real party in interest in the above-identified application is Hall Aluminum LLC, of Los Altos, CA.

II. RELATED APPEALS

The Appellant's undersigned attorney and the assignee identified above are not aware of other appeals or interferences that would directly affect or be directly affected by, or have a bearing on the Board's decision in the subject appeal.

III. STATUS OF THE CLAIMS

Claims 1-37 stand rejected under 35 USC 102(e) and 103(a) and are presently appealed.

Claims 1-5, 7, 13-17, 19, 22-24, 26, 29-31, 34, and 36 are rejected under 35 USC 102(e) over U.S. Patent Application Publication No. 2004/0254893 to Tsuei et al. (Tsuei).

Claims 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37 are rejected under 35 USC 103(a) over Tsuei in view of U.S. Patent No. 6,336,100 to Yamada (Yamada).

Claim 11 is rejected under 35 USC 103(a) over Tsuei and Yamada in view of U.S. Patent Application Publication No. 2002/0022967 to Ohkada (Ohkada).

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 is directed toward a method comprising receiving by a delivery address service via electronic communication, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber; in response, the delivery address service electronically generating a substitute delivery address; transmitting by the delivery address service via electronic communication the

substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good; receiving by the delivery address service via electronic communication, an electronic notification of either a request to deliver or an arrival of the purchased good, as a result of the substitute delivery address being used by the subscriber in the online purchase of the good; and intervening by the delivery address service by electronically accessing and communicating the mailing address provided by the subscriber as part of the electronic subscription to a delivery service to facilitate delivery of the purchased good to the subscriber at the mailing address of the subscriber, wherein the mailing address accessed and communicated by the delivery address service is retrieved from a database of the delivery address service.

The subject matter of claim 1 may be found in the specification from page 7, line 3 to page 8, line 1; page 8, lines 14-19; page 9, lines 3-13; page 11, lines 20-23; page 12, lines 2-10; page 17, line 16 to page 18, line 12; page 19, lines 1-21; and Figures 1-5, as well as elsewhere throughout the specification.

In particular, receipt by a delivery address service of an electronic subscription from a subscriber including a mailing address is provided at page 9, lines 3-4 and 6-8. The generation of a substitute mailing address and provision to the subscriber is provided at page 9, lines 11-13. Receipt of an electronic notification of a request to deliver or an arrival of a good is provided at page 11, lines 20-23; page 12, lines 7-10; and page 17, line 16 to page 18, line 5. Intervening by the delivery address service to facilitate delivery of the good is provided at page 12, lines 2-6; page 18, lines 3-12; and page 19, lines 19-21. The storage of the mailing address and correlated substitute address (and retrieval therefrom) in a database of the delivery address service is provided at page 8, lines 14-19, as well as in Figures 2 and 3, elements 106, 220/221, 225, and 230.

Independent claim 15 is directed toward a storage medium having stored therein a plurality of instructions that are machine executable, wherein when executed, the executing instructions operate to enable an address delivery service to receive a delivery address service subscription from a subscriber, including a mailing address of the subscriber, to generate a substitute delivery address, to transmit the substitute address to the subscriber, to receive a notification of a request to deliver or arrival of purchased goods for the subscriber, resulting from the substitute delivery address being used by the

subscriber in an online purchase, and to intervene by electronically accessing and communication the mailing address provided by the subscriber as part of the subscription to a delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber, wherein the mailing address accessed and communicated by the delivery address service is retrieved from a database of the delivery address service.

The subject matter of claim 15 may be found in the specification from page 7, line 3 to page 8, line 1; page 8, lines 14-19; page 9, lines 3-13; page 11, lines 20-23; page 12, lines 2-10; page 17, line 16 to page 18, line 12; page 19, lines 1-21; page 20, lines 1-13; and Figures 1-6, as well as elsewhere throughout the specification.

In particular, programming instructions and storage media are provided at page 20, lines 1-13. Receipt by a delivery address service of an electronic subscription from a subscriber including a mailing address is provided at page 9, lines 3-4 and 6-8. The generation of a substitute mailing address and provision to the subscriber is provided at page 9, lines 11-13. Receipt of an electronic notification of a request to deliver or an arrival of a good is provided at page 11, lines 20-23; page 12, lines 7-10; and page 17, line 16 to page 18, line 5. Intervening by the delivery address service to facilitate delivery of the good is provided at page 12, lines 2-6; page 18, lines 3-12; and page 19, lines 19-21. The storage of the mailing address and correlated substitute address (and retrieval therefrom) in a database of the delivery address service is provided at page 8, lines 14-19, as well as in Figures 2 and 3, elements 106, 220/221, 225, and 230.

Independent claim 22 is directed toward an apparatus comprising a storage medium having stored therein a plurality of instructions that are machine executable, wherein when executed, the executing instructions operate to enable the apparatus to receive a delivery address service subscription from a subscriber, including a mailing address of the subscriber, to generate a substitute delivery address, to transmit the substitute delivery address to the subscriber, to receive a notification of a request to deliver or arrival of purchased goods of the subscriber, resulting from the substitute delivery address being used by the subscriber in an online purchase, and to intervene by electronically accessing and communication the mailing address provided by the subscriber as part of the subscription to a delivery service to facilitate delivery of the

purchased goods to the subscriber at the mailing address of the subscriber, wherein the mailing address accessed and communicated by the delivery address service is retrieved from a database of the delivery address service; and a processor coupled to the storage medium to execute the instructions.

The subject matter of claim 22 may be found in the specification from page 7, line 3 to page 8, line 1; page 8, lines 14-19; page 9, lines 3-13; page 11, lines 20-23; page 12, lines 2-10; page 17, line 16 to page 18, line 12; page 19, lines 1-21; page 20, lines 1-13; and Figures 1-6, as well as elsewhere throughout the specification.

In particular, programming instructions, processors and storage media are provided at page 20, lines 1-13. Receipt by a delivery address service of an electronic subscription from a subscriber including a mailing address is provided at page 9, lines 3-4 and 6-8. The generation of a substitute mailing address and provision to the subscriber is provided at page 9, lines 11-13. Receipt of an electronic notification of a request to deliver or an arrival of a good is provided at page 11, lines 20-23; page 12, lines 7-10; and page 17, line 16 to page 18, line 5. Intervening by the delivery address service to facilitate delivery of the good is provided at page 12, lines 2-6; page 18, lines 3-12; and page 19, lines 19-21. The storage of the mailing address and correlated substitute address (and retrieval therefrom) in a database of the delivery address service is provided at page 8, lines 14-19, as well as in Figures 2 and 3, elements 106, 220/221, 225, and 230.

Independent claim 29 is directed toward a system for electronic delivery address service, comprising a subscription module of programming instructions configured to receive an electronic subscription from a subscriber, including the subscriber's mailing address, and generate in response, a substitute delivery address, the subscription module being further configured to cause the substitute delivery address to be transmitted to the subscriber for use in an online purchase of a good; an intervention module of programming instructions configured to receive an electronic notification of a request to deliver the purchased good by a delivery service, or an electronic notification of an arrival of the purchased good at a delivery service, as a result of the delivery address being used by the subscriber in the online purchase of the good; and the intervention module of programming instructions being further configured to retrieve the

subscriber's mailing address provided by the subscriber as part of the electronic subscription, and cause the subscriber's mailing address to be transmitted to the delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber, wherein the mailing address retrieved by the intervention module is retrieved from a database of the delivery address service.

The subject matter of claim 29 may be found in the specification from page 7, line 3 to page 8, line 1; page 8, lines 14-19; page 9, lines 3-13; page 11, lines 20-23; page 12, lines 2-10; page 17, line 16 to page 18, line 12; page 19, lines 1-21; page 20, lines 1-13; and Figures 1-6, as well as elsewhere throughout the specification.

In particular, programming instructions and storage devices are provided at page 20, lines 1-13. Receipt by a delivery address service of an electronic subscription from a subscriber including a mailing address is provided at page 9, lines 3-4 and 6-8. The generation of a substitute mailing address and provision to the subscriber is provided at page 9, lines 11-13. Receipt of an electronic notification of a request to deliver or an arrival of a good is provided at page 11, lines 20-23; page 12, lines 7-10; and page 17, line 16 to page 18, line 5. Intervening by the delivery address service to facilitate delivery of the good is provided at page 12, lines 2-6; page 18, lines 3-12; and page 19, lines 19-21. The storage of the mailing address and correlated substitute address (and retrieval therefrom) in a database of the delivery address service is provided at page 8, lines 14-19, as well as in Figures 2 and 3, elements 106, 220/221, 225, and 230.

#### VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-5, 7, 13-17, 19, 22-24, 26, 29-31, 34, and 36 are unpatentable under 35 USC 102(e) over U.S. Patent Application Publication No. 2004/0254893 to Tsuei et al. (Tsuei).

Whether claims 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37 are unpatentable under 35 USC 103(a) over Tsuei in view of U.S. Patent No. 6,336,100 to Yamada (Yamada).

Whether claim 11 is unpatentable under 35 USC 103(a) over Tsuei and Yamada in view of U.S. Patent Application Publication No. 2002/0022967 to Ohkada (Ohkada).

VII. ARGUMENT

REJECTION OF CLAIMS UNDER 35 USC 102(e)

It is well settled that anticipation under 35 U.S.C. §102 requires the clear and unambiguous disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed. Cir. 1994). Thus to anticipate the present invention, the cited reference must clearly and unambiguously disclose every element of the claim(s). Further, it is also well settled that claim terms are to be accorded the meaning given by the Applicant in the specification. See e.g. *Phillips v AWH Corp.* (CAFC 03-1269, 03-1286).

CLAIMS 1-5, 7, 13-17, 19, 22-24, 26, 29-31, 34, and 36

Claim 1 recites a method comprising, in part, a delivery address service generating a substitute delivery address; transmitting the substitute delivery address to a subscriber for the subscriber to use in an online purchase of a good; receiving by the delivery address service an electronic notification of either a request to deliver or an arrival of the purchased good, as a result of the substitute delivery address being used by the subscriber in the online purchase of the good; and intervening by the delivery address service by electronically accessing and communicating the mailing address provided by the subscriber as part of an electronic subscription to a delivery service to facilitate delivery of the purchased good to the subscriber at the mailing address of the subscriber, wherein the mailing address accessed and communicated by the delivery address service is retrieved from a database of the delivery address service.

As is clearly shown in claim 1, control over the provision, storage, access and retrieval of the subscriber's provided mailing address resides with the delivery address service. The mailing address is provided by the subscriber during a subscription process. In response, a substitute delivery address is provided by the delivery address service.

After the substitute delivery address is utilized, the delivery address service is notified and then intervenes in the process to provide the mailing address. Thus, it is the same party that provides each of these services.

In summary, claim 1 provides a delivery address service that (1) provides a substitute delivery address to a subscriber, (2) stores the mailing address provided by the subscriber during the subscription process, (3) stores and accesses the mailing address of the subscriber in its own database, (4) receives an electronic notification of a request to deliver or an arrival of the good , and (5) intervenes in the shipping process to provide the mailing address of the subscriber to the delivery service.

Tsuei does not teach a unified provider of all such services, but rather teaches multiple parties providing only some of these services, which introduces complexity and additional opportunities for anonymity to be compromised.

One method of Tsuei provides an anonymous shipping system utilizing a private mailing code, which is defined as a unique character string (see Paragraph 239). In such a method, the private mailing code obfuscates the true delivery address from an unauthorized party using the code. Such a teaching differs from that of claim 1, in that the private mailing code is formatted as a unique character string, not as a substitute address.

Additionally, Tsuei teaches the use of an alias address which can be a warehouse or disguised mailing center. The alias address is not simply a substitute address but requires identifying elements, such as an alias box number, to route the package. Thus, it is clear from a quick view of the address that it has a modified format. The method of claim 1 provides for the delivery address service to receive notification of a request to deliver or the arrival of the good, and after which, the delivery address service intervenes to provide the final shipping address. Thus, in claim 1, there is no need for a routing number other than the address itself because it is the notification step that ensures the delivery address service is involved in the process to provide the final shipping address.

Furthermore, the alias address mentioned above is provided in conjunction with embodiments that simply ship purchases to an alternate intermediate location before being rerouted to the purchaser's address. At lines 15-18 of Paragraph 232, after the package is received at the DMC, the system clearly provides that a specific request for



the mailing address is sent, and, as such, the delivery address service does not “intervene” in the process, but rather simply responds to a request.

In an alternate embodiment, in Tsuei, when a delivery is passed from a merchant to a shipper, the shipper must then contact the Private Mail Mapping Center (PMMC) to request and obtain the true address (see Paragraph 246, lines 1-6). That theme is repeated throughout embodiments of Tsuei, as it is the shipper’s relationship with the PMMC that allows it to access the PMMC database and lookup the delivery address mapped to the private mailing code. Thus, claim 1 is distinguished, in part, based on the fact that the true delivery address is “pushed” to the shipper by the delivery address service when the delivery address service intervenes, whereas, in Tsuei, the true delivery address is “pulled” from the database by the shipper or “pulled” by issuing a specific request for the shipping address.

Claim 1 specifically recites that the delivery address service receives notification of a request to deliver or the arrival of the good, and then intervenes to provide the true mailing address to the shipper. The notification of claim 1 is of a request to deliver or arrival of the good, whereas Tsuei only provides for the submission of a request for the address. In claim 1, the shipper does not request the true address, but because the delivery address service intervenes, the shipper is provided with the true delivery address. That operation of claim 1 allows for the shipper to remain unaware of the complexities and anonymity present in the system until the delivery address service intervenes and provides the final delivery address.

The Advisory Action cites Paragraphs 83-85 of Tsuei for teaching the receipt of notification of a request to deliver or the arrival of the good, and the intervention by the delivery address service to provide the mailing address. However, Paragraphs 83-85 of Tsuei do not teach the receipt of such a notification or the subsequent intervention by the delivery address service. Paragraphs 83-85, at best, provide an indication of a lookup system providing a response to a Subscriber Related Business Information Request. As provided in Paragraph 70-73, such a request initiates the transfer of subscriber information, and such request includes a header with the Subscriber’s alias, PIN and other anonymous inquiry keys. Thus, such a description provides no teaching of a notification of a request to deliver or the arrival of the good as there are in fact no goods

mentioned, nor any notification provided. In addition, there is no teaching regarding the intervention by the delivery address service as a result of receipt of a notice.

Methods of Tsuei further provide that the shipper is a partner in the system that requests the true delivery address when needed. In some situations, the shipper in Tsuei is even provided direct access to the database in which the final shipping address is stored. Clearly, such access is not provided in claim 1 in which the delivery address service maintains the database containing the shipping address and the substitute address, and the delivery address service accesses the database to provide the final shipping address upon intervening in the process.

In an embodiment as described in Paragraph 232 of Tsuei, a warehouse may be used as an alias address, but the readdressing of any such deliveries is still accomplished as a result of a request to the offline database to retrieve the true delivery address. Tsuei does not provide for the receipt of notice by a delivery address service, nor for the intervention by the delivery address service to provide the true delivery address to a delivery service.

The claimed delivery address service is thus transparent to the merchant and shipper, etc. because it utilizes a substitute delivery address that does not alert the merchant or the shipper to its use and does not require the merchant or the shipper to decode the address or to request a true delivery address be provided.

Thus, Tsuei fails to teach all the elements of claim 1, and therefore, claim 1 is patentable over Tsuei.

Independent claims 15, 22, and 29 include in substance the same recitations as described for claim 1. Thus, for at least the above stated reasons, claims 15, 22, and 29 are patentable over Tsuei.

Claims 2-5, 7, 13-14, 16-17, 19, 23-24, 26, 30-31, 34, and 36 depend, directly or indirectly, from either claim 1, 15, 22, or 29, incorporating their limitations. Therefore, for at least the same reasons discussed above, claims 2-5, 7, 13-14, 16-17, 19, 23-24, 26, 30-31, 34, and 36 are patentable over Tsuei.

#### REJECTION OF CLAIMS UNDER 35 USC 103(a)

As is well established, the Examiner bears the initial burden of factually supporting

any *prima facie* conclusion of obviousness. See MPEP 2142. To establish a *prima facie* conclusion of obviousness the factual basis must show (1) a suggestion or motivation to combine the teachings of the references; (2) a reasonable expectation of success; and (3) the combined teachings must teach or suggest all of the claim limitations. *Id*; see also MPEP 706.02(j). The Supreme Court in *Graham v. John Deere Co.* set out the inquiries necessary to develop this factual basis. 383 U.S. 1, 17-18 (1966); see also MPEP 2141. These inquiries include determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims at issue; and resolving the level of ordinary skill in the art.

The Examiner has clearly failed to provide a sufficient factual basis to support a *prima facie* case of obviousness of claims 6, 8-11, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37.

In particular, ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. See MPEP 2141.02. This has not been done, as further detailed below.

CLAIMS 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37

Yamada fails to overcome the deficiencies of Tsuei discussed above. Thus, in light of the arguments with respect to claims 1, 15, 22, and 29, Applicant respectfully submits that claims 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37 are patentable over Tsuei and Yamada, whether alone or in combination.

In particular, Yamada does not provide for notifying the subscriber of the arrival of the purchased goods (claim 6 and similar dependent claims), providing a mailing address of the subscriber to the delivery service (claim 8 and similar dependent claims), or receiving by the delivery address service a confirmation of a purchase (claim 10 and similar dependent claims). These features have been completely taken out of the context in which they are provided.

For example, claim 6 provides further detail regarding the intervention by the delivery address service in which the delivery address service notifies the subscriber of the arrival of the purchased goods. Because of the anonymity of the system recited in

claim 6, the subscriber would not have an opportunity to be notified until the delivery address service has first been notified. The citation of Yamada providing notice in an open shipping system provides no teaching of the centralized delivery address service providing the additional service of notifying the subscriber.

The different contexts of the two references further indicate that the express teachings of Yamada teach away from its combination with Tsuei. Yamada teaches the discrimination of members of the shopping service by the provision of information to a merchant. That information can include an alternative location to which a good may be shipped. However, at all times the purchaser is known by the merchant and the shippers within the chain.

The present claims clearly maintain the anonymity of the user. The mailboxes merely provide a defined physical location that comprises the substitute delivery address. That address is determined by the electronic delivery address service, and is further transparent to the merchant/shipper.

Thus, since anonymity is also an important feature of Tsuei, one of ordinary skill in the art of anonymous shipping methods would not look to an open on-line shopping system to make the suggested modifications. In addition, because of the different contexts of the references, the attempted combination stretches the teachings of the references beyond what was intended in order to attempt to cover the present claims.

Furthermore, with respect to the motivation to combine Tsuei and Yamada, the Final Office Action only provides a conclusory indication of motivation. The provided motivation is that “it would have been obvious . . . to include the notification and confirmation, as taught by Yamada, in order to deliver and confirm that the commodity has been delivered to the customer’s designation (Yamada, col. 3, lines 55-60).”

Courts have repeatedly held that a clear explanation of the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious must be provided by the Examiner. *In re Rouffet*, 149 F.3d 1350, 1357 – 59 (Fed. Cir. 1998). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006). The Examiner has failed to

articulate a rational basis as to why one skilled in the art would be motivated to combine the teachings of the cited references in a manner to make the invention, other than a conclusory statement that simply restates Applicant's claims. Clearly, the Examiner has resorted to improper hindsight to attempt to establish such motivation.

Therefore, as stated above, claims 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37 are patentable over Tsuei and Yamada, whether alone or in combination.

#### CLAIM 11

Ohkada fails to overcome the deficiencies of Tsuei and Yamada discussed above. Thus, in light of the arguments with respect to claim 1, Applicant submits that claim 11 is patentable over Tsuei, Yamada, and Ohkada, whether alone or in combination.

Claim 11, in particular, provides for a subscriber providing confirmation to the delivery address service of a purchase that has been made. Contrarily, Ohkada provides for a system in which the subscriber provides to the service provider an anonymous ID issued by a merchant to be correlated with the subscriber's member ID. Such a teaching does not provide for the subscriber to notify the service provider of the purchase, but rather notifies the service provider only of the merchant's anonymous ID. While the service provider may know that a purchase has been made, the subscriber has provided no direct notice, and, furthermore, the substance of that purchase is not communicated. In claim 11, a confirmation "of the purchase" is provided which alerts the delivery address service and provides relevant information about the purchase. This provides a check on the system since the delivery address service will be notified of the request to deliver or the arrival of the good, and having already received notification from the subscriber of the purchase, the delivery address service can easily compare the two notifications to ensure the goods match.

In addition, the different contexts of the two references indicate that the express teachings of Yamada teach away from its combination with Tsuei and Ohkada. Yamada teaches the discrimination of members of the shopping service by the provision of information to a merchant. That information can include an alternative location to which a good may be shipped. However, at all times the purchaser is known by the merchant and the shippers within the chain.

The present claims clearly maintain the anonymity of the user. The mailboxes merely provide a defined physical location that comprises the substitute delivery address. That address is determined by the electronic delivery address service, and is further transparent to the merchant/shipper.

Thus, since anonymity is also an important feature of Tsuei, one of ordinary skill in the art of anonymous shipping methods would not look to an open on-line shopping system to make the suggested modifications. In addition, because of the different contexts of the references, the attempted combination stretches the teachings of the references beyond what was intended in order to attempt to cover the present claims.

Furthermore, with respect to the motivation to combine Tsuei, Yamada, and Ohkada, the Final Office Action only provides a conclusory indication of motivation. The provided motivation is that “it would have been obvious . . . to include the delivery address service receives a confirmation from the subscriber, in order to ensure the anonymity of customers during the delivery of purchases (Ohkada, paragraph 15).”

Courts have repeatedly held that a clear explanation of the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious must be provided by the Examiner. *In re Rouffet*, 149 F.3d 1350, 1357 – 59 (Fed. Cir. 1998). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006). The Examiner has failed to articulate a rational basis as to why one skilled in the art would be motivated to combine the teachings of the cited references in a manner to make the invention, other than a conclusory statement that simply restates a purpose of Applicant’s claims. Clearly, the Examiner has resorted to improper hindsight to attempt to establish such motivation. Additionally, the cited motivation is directly counter to the teachings of Yamada, in which anonymity is not maintained.

Therefore, as stated above, claim 11 is patentable over Tsuei, Yamada, and Ohkada, whether alone or in combination.

# VIII. CONCLUSION

Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is filed with a check for \$500 to cover the appeal fee for one other than a small entity as specified in 37 C.F.R. § 1.17(c). We do not believe any other fees are needed. However, should it be necessary, please charge Deposit Account No. 500393. In addition, please credit any overages to the same account.

SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: 09-11-2006

/Steven J. Prewitt/

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## CLAIMS APPENDIX

1. (Previously Presented) In an electronic delivery address service, a method comprising:

receiving by the delivery address service via electronic communication, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber;

in response, the delivery address service electronically generating a substitute delivery address;

transmitting by the delivery address service via electronic communication the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good;

receiving by the delivery address service via electronic communication, an electronic notification of either a request to deliver or an arrival of the purchased good, as a result of the substitute delivery address being used by the subscriber in the online purchase of the good; and

intervening by the delivery address service by electronically accessing and communicating the mailing address provided by the subscriber as part of said electronic subscription to a delivery service to facilitate delivery of the purchased good to the subscriber at the mailing address of the subscriber, wherein said mailing address accessed and communicated by said delivery address service is retrieved from a database of said delivery address service.

2. (Original) The method of claim 1, wherein the method further comprises the delivery address service correlating the substitute delivery address to the mailing address of the subscriber.

3. (Original) The method of claim 1, wherein the substitute delivery address comprises one of a plurality of mailboxes pre-established with a mailbox service by the delivery address service.

4. (Original) The method of claim 3, wherein the method further comprises the



delivery address service selecting a mailbox proximately located with the mailing address of the subscriber, for use as the substitute delivery address.

5. (Original) The method of claim 3, wherein said receiving by the delivery address service of a notification comprises receiving by the delivery address service a notification from a mailbox service with respect to the arrival of the purchased goods.

6. (Original) The method of claim 5, wherein said intervening by the delivery address service comprises said delivery address service notifying said subscriber of the arrival of the purchased goods.

7. (Original) The method of claim 1, wherein the substitute delivery address comprises one of a plurality of virtual delivery address artificially created by the delivery address service.

8. (Original) The method of claim 7, wherein said receiving of a notification comprises receiving a notification of a request to deliver a purchased good from a delivery service, and the method further comprises providing the mailing address of the subscriber to the delivery service.

9. (Previously Presented) The method of claim 8, wherein said intervening by the delivery address service comprises the delivery address service automatically providing said mailing address of the subscriber to the delivery service.

10. (Previously Presented) The method of claim 1, wherein the method further comprises receiving a confirmation by the delivery address service of the purchase.

11. (Original) The method of claim 10, wherein the delivery address service receives the confirmation from the subscriber.

12. (Original) The method of claim 10, wherein the delivery address service receives

the confirmation from an online business from which the goods to be delivered was purchased.

13. (Original) The method of claim 1, wherein the subscriber is a purchaser of the goods.

14. (Original) The method of claim 1, wherein the subscriber is a beneficiary of the purchase.

15. (Previously Presented) A storage medium having stored therein a plurality of instructions that are machine executable, wherein when executed, said executing instructions operate to enable an address delivery service to receive a delivery address service subscription from a subscriber, including a mailing address of the subscriber, to generate a substitute delivery address, to transmit the substitute address to the subscriber, to receive a notification of a request to deliver or arrival of purchased goods for the subscriber, resulting from the substitute delivery address being used by the subscriber in an online purchase, and to intervene by electronically accessing and communication the mailing address provided by the subscriber as part of said subscription to a delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber, wherein said mailing address accessed and communicated by said delivery address service is retrieved from a database of said delivery address service.

16. (Original) The storage medium of claim 15, wherein said executing instructions further operate to correlate the subscription delivery address with the mailing address of the user.

17. (Original) The storage medium of claim 15, wherein said executing instructions further enable the delivery address service to provide one of a plurality of pre-established mailboxes as the substitute delivery address.

18. (Original) The storage medium of claim 17, wherein said executing instructions further enable the delivery address service to receive a notification of the arrival of the purchased goods from a mailbox service, and to notify the subscriber of the arrival.

19. (Original) The storage medium of claim 15, wherein said executing instructions further enable the delivery address service to provide one of a plurality of virtual delivery addresses as the substitute delivery address.

20. (Original) The storage medium of claim 19, wherein said executing instructions further enable the delivery address service to receive a notification of a request to deliver the purchased goods from a delivery service, and to provide the mailing address of the subscriber to the delivery service.

21. (Original) The storage medium of claim 15, wherein said executing instructions further enable the delivery address service to receive a confirmation of the online purchase.

22. (Previously Presented) An apparatus comprising:

a storage medium having stored therein a plurality of instructions that are machine executable, wherein when executed, said executing instructions operate to enable the apparatus to receive a delivery address service subscription from a subscriber, including a mailing address of the subscriber, to generate a substitute delivery address, to transmit the substitute delivery address to the subscriber, to receive a notification of a request to deliver or arrival of purchased goods of the subscriber, resulting from the substitute delivery address being used by the subscriber in an online purchase, and to intervene by electronically accessing and communication the mailing address provided by the subscriber as part of said subscription to a delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber, wherein said mailing address accessed and communicated by said delivery address service is retrieved from a database of said delivery address service; and

a processor coupled to said storage medium to execute said instructions.

23. (Original) The apparatus of claim 22, wherein said executing instructions further operate to correlate the subscription delivery address with the mailing address of the user.

24. (Original) The apparatus of claim 22, wherein said executing instructions further enable the delivery address service to provide one of a plurality of pre-established mailboxes as the substitute delivery address.

25. (Original) The apparatus of claim 24, wherein said executing instructions further enable the delivery address service to receive a notification of the arrival of the purchased goods from a mailbox service, and to notify the subscriber of the arrival.

26. (Original) The apparatus of claim 22, wherein said executing instructions further enable the delivery address service to provide one of a plurality of virtual delivery addresses as the substitute delivery address.

27. (Original) The apparatus of claim 26, wherein said executing instructions further enable the delivery address service to receive a notification of a request to deliver the purchased goods from a delivery service, and to provide the mailing address of the subscriber to the delivery service.

28. (Original) The apparatus of claim 22, wherein said executing instructions further enable the delivery address service to receive a confirmation of the online purchase.

29. (Previously Presented) A system for electronic delivery address service, comprising:

a subscription module of programming instructions configured to receive an electronic subscription from a subscriber, including the subscriber's mailing address, and generate in response, a substitute delivery address, the subscription module being further configured to cause the substitute delivery address to be transmitted to the

subscriber for use in an online purchase of a good;

an intervention module of programming instructions configured to receive an electronic notification of a request to deliver the purchased good by a delivery service, or an electronic notification of an arrival of the purchased good at a delivery service, as a result of the delivery address being used by the subscriber in the online purchase of the good; and

the intervention module of programming instructions being further configured to retrieve the subscriber's mailing address provided by the subscriber as part of said electronic subscription, and cause the subscriber's mailing address to be transmitted to the delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber, wherein said mailing address retrieved by the intervention module is retrieved from a database of said delivery address service.

30. (Previously Presented) The system of claim 29, wherein the intervention module is further adapted to correlate the substitute delivery address to the mailing address of the subscriber.

31. (Previously Presented) The system of claim 29, wherein the subscription module is further adapted to select a mailbox proximately located with the mailing address of the subscriber, for use as the substitute delivery address.

32. (Previously Presented) The system of claim 29, wherein said intervention module is further configured to receive an electronic notification from a mailbox service with respect to the arrival of the purchased goods.

33. (Previously Presented) The system of claim 29, wherein said intervention module is further configured to notify said subscriber of the arrival of the purchased goods.

34. (Previously Presented) The system of claim 32, wherein the substitute delivery address comprises one of a plurality of virtual delivery address artificially generated by a virtual delivery address module of programming instruction.

35. (Previously Presented) The system of claim 32, wherein said notification module of programming instruction configured to receive an electronic notification comprises programming instruction configured to receive an electronic notification of a request to deliver a purchased good from a delivery service, and retrieving the subscriber's mailing address to provide the mailing address of the subscriber to the delivery service.

36. (Previously Presented) The system of claim 33, wherein said intervention module comprises programming instruction configured to automatically provide said mailing address of the subscriber to the delivery service.

37. (Previously Presented) The system of claim 29, wherein the system further comprises a confirmation module of programming instruction configured to receive an electronic confirmation of the purchase.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.